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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92045288
Party	Defendant KINETIC MARKETING INC. KINETIC MARKETING INC. 1133 BROADWAY NEW YORK, NY 10010
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Date	03/23/2006
Attachments	Qinetiq Reply to Motion to Consolidate.pdf (6 pages)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Qinetiq Limited

Petitioner,

v.

Kinetic Marketing Inc.

Registrant

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Cancellation No. 92045288

**OPPOSER'S REPLY TO APPLICANT'S MOTION TO CONSOLIDATE
AND REGISTRANT'S MOTION TO SUSPEND ALL PROCEEDINGS PENDING
DISPOSITION OF PETITIONER'S MOTION TO CONSOLIDATE**

Qinetiq Limited (hereinafter Qinetiq or Petitioner) filed a Motion to Consolidate three proceedings for pre-trial and trial proceedings. Kinetic Marketing Inc., (hereinafter Kinetic or Registrant) opposes Qinetiq's Motion because (a) the three proceedings involve separate, discrete and unrelated issues of fact and law; (b) it is premature and (c) Opposer will be unduly prejudiced if this Motion is granted without specific restrictions.

Further, because the decision of the Trademark Trial and Appeal Board on this issue will directly impact Registrant's preparation of its pre-trial and trial strategy, as well as responding to Petitioner's pre-trial and trial strategy, it is respectfully requested that all proceedings be suspended until disposition of this Motion by the Board.

Registrant also requests that the Board stay all term dates with respect to both parties' responses to outstanding Discovery requests. The Request to Suspend is not being made for purposes of delay. Rather it is believed in good faith that given the nature of all three

proceedings, Registrant requires clear guidance from the Board as to how the matters are to be handled prior to trial and during trial.

I. INTRODUCTION

There are three separate proceedings:

1. Cancellation No. 92045288.

This , filed on November 22, 2005, concerns abandonment, (hereinafter “The Computer Abandonment Case”).

Qinetiq petitioned to cancel computers and computer programs in Registration No. 1,454,126. Registrant denied the claims.

Qinetiq has served Interrogatories, Document Requests and Admission Requests.

2. Opposition No. 91168895.

This was filed on January 25, 2006, concerns the issue of likelihood of confusion under Section 2(d), (hereinafter “The Confusion Case”).

Kinetic opposed Application No. 76/977558 for QINETIQ for cameras based on its prior registration of KINETIC for cameras, Registration No. 1,951,402.

Both parties have served written Discovery requests.

Qinetiq has also filed a separate Motion to amend the description of goods in Application No. 76/977556. Registrant has opposed this Motion and has separately filed a request to suspend the opposition until Petitioner’s motion concerning the amendment is decided.

3. Cancellation No 92045572

This was filed by Qinetiq on March 13, 2006, concerns non-use with respect to certain camera goods in Registration No. 1,951,402, (hereinafter “The Camera Abandonment Case”).

Kinetic must file an Answer no later than April 22, 2006.

To date neither party has served written Discovery.

II. REGISTRANT'S MOTION IS PREMATURE

Registrant filed Cancellation No. 92045572 on March 13, 2006. Petitioner has not yet fled an Answer. Therefore the Motion to Consolidate is premature. Section 511 of the Trademark Manual of Board Procedure states:

Generally, the Board will not consider a motion to consolidate until an answer has been filed in each case sought to be consolidated.

II. THE THREE PROCEEDINGS INVOLVE SEPARATE ISSUES OF FACT AND LAW AND THEREFORE ARE NOT RIPE FOR CONSOLIDATION.

It is Qinetiq's position that since the three proceedings involve the same parties and the same marks, consolidation is appropriate. There is a flaw in this analysis. The cases do not involve common issues of law or fact.

The Computer Abandonment Case involves Qinetiq's claim that Registrant has abandoned its rights in KINETIC with respect to computers and computers programs. To prove abandonment Petitioner must establish that there has been non-use with an intent not to resume use.

The Confusion Case involves Kinetic's claim that Qinetiq's registration of QINETIQ for cameras will cause confusion with its registration of KINETIC for the identical goods. The issues concern priority, the similarity of the marks and the relatedness of the goods. Non-use is not a factor. Thus it is apparent on its face that not only are the goods involved in this proceeding different from those in The Computer Abandonment Case, but so are the evidentiary

burdens and the statutory provisions. Registrant's success in the cancellation will have no affect on the outcome of the opposition. Concomitantly, Opposer's success in the opposition is not related to the cancellation.

The Camera Abandonment Case concerns Petitioner's attempt to partially cancel the certain cameras goods from Registrant's incontestable registration for KINETIC. Registrant's answer is not due until April and therefore it is submitted that Qinetiq's Motion to Consolidate is premature. TMBP §511.

Moreover The Camera Abandonment Case has no bearing on The Computer Abandonment Case. The goods are completely different, and while the issue of law is the same the facts related thereto are not.

Inasmuch as each of the three proceedings concern different facts and applications of law, consolidation is not appropriate and Kinetic objects.

However, Kinetic will not object to said Motion to the extent that evidence obtained through Discovery in one proceeding may be relied on in another proceeding provided that:

(a) it is clearly established that said evidence is relevant to the issues in the other proceeding; and any dispute is resolved in Kinetic's favor;

(b) the Board sets forth a new discovery and trial schedule so that each of the proceedings is following one schedule; and

(c) Kinetic is not prejudiced in any proceeding by this Motion to Consolidate. Accordingly Qinetiq should be precluded from strategically using a Motion to Compel in connection with The Abandonment Cancellation Case to challenge Kinetic's rights in The Confusion or Partial Abandonment Case.

MOTION TO SUSPEND

Kinetic moves to suspend these proceedings, including staying the term dates for both parties to respond to outstanding Discovery requests until the Board has had the opportunity to consider the Petitioner's Motion to Consolidate. The Motion to Suspend is not being made for purposes of delay. Rather it is believed in good faith that law and equity supports the motion.

The facts and law in each of the three proceedings is different. Therefore, it is Registrant's position that the Motion to Consolidate should be denied for the reasons articulated above. If it is denied, registrant will attend to each proceeding as discrete and unrelated proceedings.

Registrant has also separately requested that specific guidelines be established in the event the Board grants the Motion to Consolidate. In such case, Registrant must assess what facts are common to all proceedings and what are not and plan its strategy accordingly.

However, if the Board grants the Motion to Consolidate, Registrant must abide by this decision and adapt its pre-trial and trial strategy to accommodate that set of circumstances.

In sum, Registrant should not be forced into a position of predicting the Board's analysis of the Motion to Consolidate, and simultaneously be expected to serve and respond to Discovery and Testimony. Registrant and Petitioner should be afforded the opportunity to evaluate their pre-trial and trial strategy within the context of the Board's decision on Qinetiq's Motion to Consolidate.

Inasmuch as it was Petitioner who requested that the cases be consolidated, Petitioner should not be heard to challenge the merits of the Motion to Suspend

Respectfully submitted,



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CERTIFICATE OF SERVICE

I hereby certify that the foregoing was served by first class mail, postage prepaid this 23rd day of March 2006 upon the following:

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